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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,251

03/09/2005

Jean Taylor

5910-273

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65901

7590

11/24/2009

MEDTRONIC

Attn: Noreen Johnson - IP Legal Department

2600 Sofamor Danek Drive

Memphis, TN 38132

EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

11/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,251	Applicant(s) TAYLOR, JEAN	
	Examiner Nicholas Woodall	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-21, 26-28, 33 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-21, 26, 27 and 36-40 is/are allowed.
- 6) ☒ Claim(s) 28, 33, 35, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/09/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on July 9th, 2009.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 28, 33, 35, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pasquet (U.S. Publication 2004/0117017) in view of Taylor (U.S. Patent 6,626,944) and Senegas (U.S. Publication 2004/0024458).

4. Claims 28, 33, 35, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pasquet (U.S. Publication 2004/0117017) in view of Taylor (U.S. Patent 6,626,944).

Pasquet discloses a device comprising an interspinous wedge (10) inserted between the spinous processes of two vertebrae, a strap comprising two elements engaged around the two spinous processes and the wedge, and first and second lateral transmission elements disposed between the strap and the wedge. The wedge includes a first end and a second opposite end, wherein each end comprises a recess bound by two lugs, wherein the recesses are shaped to receive the spinous processes and first and second lateral sides extending from the first end to the second end. The strap forms a first and a second compressive element disposed on opposite lateral sides of the wedge to maintain the position of the wedge. The lateral transmission elements include

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small bars (34) connected to a support plate, wherein the lateral transmission elements are disposed between the strap and the wedge and are capable of pressing against the middle of the lateral sides in a direction transverse to the longitudinal axis of the wedge and do not extend through a sagittal plane defined by the spinous processes in the space between the spinous processes. Pasquet fails to disclose the device wherein the wedge includes at least one elastically deformable zone and the strap comprising a single element. Taylor teaches an interspinous wedge manufactured from a multi-directionally flexible and elastic material including at least one elastically deformable zone in order to provide a device that allows the lugs to "self close" against the lateral faces of the spinous apophyses during compression (column 2 lines 4-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the wedge of Pasquet manufactured from a multi-directionally flexible and elastic material including at least one elastically deformable zone in view of Taylor in order to provide a device that allows the lugs to "self close" against the lateral faces of the spinous apophyses during compression.

Regarding the strap comprising a single element, Pasquet discloses a device comprising a strap that includes two separate elements in order to fix the device to two adjacent spinous processes. Senegas teaches a device comprising an interspinous wedge and a strap comprising a single element in order to fix the device to two adjacent spinous processes. Because both the device of Pasquet and the device of Senegas teach device comprising straps, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one strap for the other in

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order to achieve the predictable results of fixing the interspinous wedge to two adjacent spinous processes.

Allowable Subject Matter

5. Claims 14-21, 26, 27, and 36-40 are allowed.

Response to Arguments

6. Applicant's arguments filed July 9th, 2009 have been fully considered but they are not persuasive. The applicant's argument that the single strap teaching of the Senegas reference can not be used to modify the Pasquet reference is not persuasive. The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Therefore, the test for obviousness is not whether the one strap teaching of the Senegas reference may be bodily incorporated into the disclosed invention of the Pasquet reference as argues by the applicant. The test for obviousness is if the combination of references would make obvious that the disclosed device of the Pasquet reference could be modified to include a single strap as taught by Senegas instead of a double strap as disclosed in the reference. Because both the Pasquet reference and the Senegas reference disclose interspinous wedges coupled to the spinous processes by a coupling element, i.e. straps. Since both references are directed to similar devices, i.e. interspinous wedges, the combination of references would have made it obvious to one having ordinary skill in the art to modify the Pasquet reference by substituting the double strap coupling element with a single strap coupling element as taught by the Senegas reference to

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achieve the predictable results of fixing, i.e. coupling, the interspinous wedges to the spinous processes. The examiner has not provided any new grounds of rejection making this office action **FINAL**.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775